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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,477	01/18/2002	Michael C. Stewart	80121-05730	5572
758	7590	11/26/2007		
FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			EXAMINER KASZTEJNA, MATTHEW JOHN	
			ART UNIT 3739	PAPER NUMBER
			MAIL DATE 11/26/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/054,477

Applicant(s)

STEWART ET AL.

Examiner

Matthew J. Kasztejna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 84,90-96,99,103,104,107-113 and 116-121 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 84,90-96,99,103,104,107-113 and 116-121 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/21/07</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 4, 2007 has been entered.

### ***Notice of Amendment***

In response to the amendment filed on May 4, 2007, amended claims 84, 90-91, 93-94, 99, 107-108 and 110-111; canceled claims 85, 88-89, 97-98, 100, 105-106 and 114-115; and new claims 120-121 are acknowledged. The following new and reiterated grounds of rejection are set forth:

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 84, 93-94, 96, 99, 103-104, 110-111, 113, and 116-119 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent No. 5,725,479 to Knight et al.

**In regards to claims 84 and 99**, Knight et al. disclose a tissue dissector comprising: an elongated tube 12 having a proximal end and a distal end and enclosing an endoscopic imaging element 5; and a dissecting, viewing and dilating unit 16 removably mounted on the distal end of the tubular body (see Fig. 16 and Col. 7, Lines 1-20), including; a transparent distal tip 16 having substantially conical tapered outer walls converging to a blunt end for dissecting tissue, the tip being disposed on a distal end of the dilating unit to dissect tissue and facilitate passage of the tubular body through tissue under endoscopic visualization (see Figs. 1-2); and a non-inflatable dilating element having a substantially olive-shaped or ovoidal exterior contour that gradually increase in size in the proximal direction from a distal edge thereof to a maximum cross-sectional dimension greater than the cross-sectional dimension of the distal end of the tubular body, the dilating element then decreasing in size to a proximal edge, for facilitating atraumatic expansion of tissue following dissection by the tapered distal tip (see Figs. 4-5 and Col. 4, Line 55 – Col. 5, Line 10).

**In regards to claims 93-94 and 110-111**, Knight et al. disclose a tissue dissector, wherein the maximum cross-sectional dimension of the dilating element is at least two times larger than the cross-sectional dimension of the distal end of the tubular body (see Figs. 1-2).

**In regards to claims 103-104**, Knight et al. disclose a tissue dissector having a removable dilating unit attached to the distal end of the flexible tube including a length of screw threads positioned on an outer surface of the tubular body near the distal end thereof, and wherein the dilating unit further comprises a threaded bore hole for

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engaging the length of screw threads and mounting the dilating unit on the distal end of the tubular body (see Fig. 16 and Col. 7, Lines 1-20).

**In regards to claims 96 and 113**, Knight et al. disclose a tissue dissector, wherein the tubular body is an endoscope 5 (see Col. 4, Lines 55-67).

**In regards to claims 116-119**, Knight et al. disclose a tissue dissector, wherein the dilating element 16 is rigid and solid (see Col. 7, Lines 21-26).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 90-92, 95, 107-109, 112 and 120-121 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,725,479 to Knight et al. in view of U.S. Patent No. 5,688,286 to Yoon.

**In regards to claims 90-92, 95, 107-109, 112 and 120-121**, Knight et al. disclose a tissue dissector having a removable dilating unit attached to the distal end of the flexible tube but are silent with respect peripheral faceted surfaces located distally on the tip, wherein the exterior of the dilating element includes axially aligned ribs and wherein the tip is compressible. Yoon teaches of an analogous medical apparatus wherein distal end 64 is illustrated in Figs. 7 and 8 at 158 with the primary difference being that, while the inner surface 159 of "conical" wall 148 has a configuration mating with neck 48 and shoulder 50 of the trocar tip, the outer surface of wall 148 has flat

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sides or facets 160 having configurations to form extensions of trocar tip facets 140 (see Col. 9, Line 59 – Col. 10, Line 21 and Col. 12, Lines 8-32). It would have been obvious to one skilled in the art at the time the invention was made to construct the dilating element in the apparatus of Knight et al. with faceted surfaces to assist in dilating tissue during operation as taught by Yoon.

### ***Response to Arguments***

Applicant's arguments filed May 4, 2007 have been fully considered but they are not persuasive.

Applicant states that Knight fails to disclose a *substantially* conical dissecting tip and an element that is located proximally of the dissecting tip that has a *substantially* ovoidal or olive shape for dilating tissue following dissection thereof by the dissecting tip. Examiner disagrees. As seen in Figures 4-5 of Knight, the working head 16 is constructed in a *substantially* ovoidal or olive shape.

In response to applicant's argument that Yoon is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Yoon teaches of safety shields placed on the distal end of surgical instruments used for accessing cavities within the body. Similarly, Knight teaches of a working element placed on the distal end of a surgical instrument used for accessing cavities within the body.

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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJK 

11/15/07

  
LINDA C.M. DVORAK  
SUPERVISORY PATENT EXAMINER  
GROUP 3700